

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

126587-0026

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on _____

Signature _____

Typed or printed name _____

Application Number

10/541,268

Filed

04/13/2006

First Named Inventor

Jaewan BYUN et al.

Art Unit

2617

Examiner

Sayed T Zewari

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Yoon S Ham/

Signature

☐

assignee of record of the entire interest.

Yoon S. Ham

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Typed or printed name

☒

attorney or agent of record.

45,307

703-535-7340

Registration number _____

Telephone number

☐

attorney or agent acting under 37 CFR 1.34.

September 23, 2008

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	:	EXPEDITED PROCEDURE
	:	:	Response under 37 CFR 1.116
Jaewan BYUN et al.	:	:	
	:	:	
Serial No. 10/541,268	:	:	Group Art Unit: 2617
	:	:	
Filed: April 13, 2006	:	:	Examiner: Sayed T Zewari
	:	:	

For: METHOD AND SYSTEM FOR RECOVERING FROM HAND-OFF FAIL FOR USE IN
CDMA 2000 1XEV-DO SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This paper is submitted in reply to the Final Office Action mailed *June 23, 2008*.

Applicants respectfully request review of the final rejections of all claims as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the Examiner's rejections.

All art rejections are traversed for the reasons detailed in the Response filed April 10, 2008, pages 2-4, which are incorporated herein by reference.

The Examiner responded to Applicants' previous arguments in the Final Office Action, at paragraphs 1-4. Applicants will now address each of the additional points raised in the Examiner's Response to Applicants' argument as follows:

1. As to claim 1, the primary distinction between the claimed invention and the art, especially *Tiedemann*, was identified in Applicants' Response, i.e., the claimed invention is directed to system-based hand-off recovery whereas the art concerns with terminal-based hand-off recovery.¹ This is evident from the *Tiedemann* sections cited by the Examiner.²

In response to the above argument, the Examiner insisted ³ that (i) *Tiedemann* discloses a hand-off recovery system, (ii) *Turner* discloses an EV-DO system, and (iii) the combination discloses the claimed invention. Applicants respectfully disagree.

Fore the sake of simplicity, assuming *arguendo* that the references can be properly combined (which Applicants contend to the contrary), the Examiner's combination is summarized in the Table below.

¹ See Response at page 3 the second paragraph.

² See Final Office Action at page 5, lines 11-12.

³ See Final Office Action at paragraph 2.

Prior art	Teachings	
<i>Turner</i>	EV-DO system	EV-DO terminal
<i>Tiedemann</i>		Terminal-based hand-off failure recovery
<i>Turner + Tiedemann</i>	EV-DO system	Terminal-based hand-off failure recovery
Claimed invention	EV-DO system System-based hand-off failure recovery	

As can be seen from the Table, the Examiner's proposed combination would result in, at best, an EV-DO system with still a *terminal*-based hand-off failure recovery. To the contrary, the claimed invention comprises, among other things, an EV-DO system with a *system*-based hand-off failure recovery. There is no articulated reason (schematically indicated as the arrow in the Table) in the Final Office Action as to why a person of ordinary skill in the art would have *further modified* the *Tiedemann* terminal-based hand-off failure recovery to be used at the system side in the presently claimed manner. The combination, as *currently* formulated by the Examiner, apparently lacks the claimed *system*-based hand-off failure recovery.

The sustained 35 U.S.C. 103(a) rejection of claim 1 is therefore clearly erroneous.

2. Still with respect to claim 1, Applicants argued that the references singly or in combination do not teach or suggest the claimed "EV-DO access network controller... re-transmitting the traffic channel assignment signal to the hybrid access terminal if a response signal (L2ACK) is not transmitted thereto from the hybrid access terminal, thereby performing the hand-off..."⁴ In other words, the claimed system tries to recover from a hand-off failure upon receiving *no* response from the terminal. In contrast, *Tiedemann* discloses that a second attempt at hand-off

⁴ See Response at page 3, the third paragraph through page 4, the first full paragraph.

might occur, however, after the terminal has reported the hand-off failure to the system,⁵ i.e., upon receiving *some* response from the terminal. The claimed feature and the teachings of *Tiedemann* are different, and hence, the Examiner's proposed combination of *Turner* with *Tiedemann* would fail to include the claim feature.

The Examiner, in response to Applicants' argument,⁶ appeared to completely disregard at least the above-highlighted text of claim 1 which is improper. The Examiner's failure to properly consider the claim feature has led to the clearly erroneous holding of obviousness as detailed above.

The Examiner further cited Applicants' specification⁷ in an apparent attempt to read the specification into the claim, which is also improper.

For any of the reasons presented above, the obviousness rejection of claim 1, as *currently* formulated by the Examiner, is clearly erroneous and should be withdrawn.

Claims 2-12 depend on, or otherwise include limitations similar to, claim 1 and should be considered patentable over the art as *currently* applied.

3. As to claim 3, the Examiner improperly held that all claim features are found in *Turner*. Applicants respectfully disagree for at least two reasons.

First, the Examiner admitted, with respect to claim 1, that *Turner* does not explicitly disclose a system for recovering from a hand-off fail,⁸ and had to rely on *Tiedemann* for such a hand-off failure recovery system. All features of claim 3 are directed to a system for recovering from a hand-off fail. Thus, by the Examiner's own admission, *Turner* could not be cited as teaching all limitations of claim 3.

⁵ *Tiedemann* at column 3 line 63.

⁶ See Final Office Action at page 2, lines 6-10 from bottom.

⁷ See Final Office Action at page 2, line 5 from bottom through page 3, line 4.

⁸ See Final Office Action at page 6, lines 7-8 from bottom.

Second, contrary to the Examiner's allegation, *Turner* fails to teach or suggest all features of claim 3, e.g., "if the EV-DO system receives the response signal (L2ACK) from the hybrid access terminal in response to the traffic channel assignment signal, the EV-DO system transmits an acknowledge signal for a reverse traffic channel to the hybrid access terminal, and then, re-transmitting the traffic channel assignment signal to the hybrid access terminal if a traffic channel completion signal is not transmitted to the EV-DO system from the hybrid access terminal, thereby performing the hand-off."

In other words, the claimed EV-DO system *re*-transmits the traffic channel assignment (TCA) signal a second time *even through the terminal has acknowledged it before*. The claim feature finds support in at least FIG. 4 where it is disclosed that the EV-DO system sends the TCA signal a second time (S470 ~ S440) even through the terminal has acknowledged (S442) it before. The claimed limitation can be found nowhere in both applied references, especially the cited portions of *Turner*.

The 35 U.S.C. 103(a) rejection of claim 3, and likewise, claim 10, is therefore clearly erroneous.

Withdrawal of the final rejections of all claims in view of the above is believed appropriate and therefore respectfully requested.

Serial No. 10/541,268

To the extent necessary, a petition for an extension of time under *37 C.F.R. 1.136* is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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